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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/645,833 | 08/20/2003 | Grzegorz J. Kusinski | 020030-000910US | 7656 |

20350 7590 06/27/2006

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| EXAMINER | |
|---|---|
| YEE, DEBORAH | |
| **ART UNIT** | **PAPER NUMBER** |
| 1742 | |

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/645,833 | KUSINSKI ET AL. | |
| | Examiner | Art Unit | |
| | Deborah Yee | 1742 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *19 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15 and 17-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 17-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 19,2006 has been entered.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 to 15, and 17 to 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 20 of U.S. Patent No. 6,273,968. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose high-strength high-ductile alloy carbon steels having been processed in substantially the same manner. Although patent '968 claims do not recite cold deforming to achieve high tensile

strength, such step is taught on lines 1 to 8 of column 6, which states "The steel alloys of this invention are particularly useful in products that require **high tensile strengths** and are manufactured by processes involving **cold forming** operations, since the microstructure of the alloys lends itself particularly well to cold forming".

4. Claims 1 to 15 and 17 to 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 3 of U.S. Patent No. 4,619,714. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose high-strength high-ductile alloy carbon steels having been processed in substantially the same manner. Although patent '714 discloses treating a steel having a ferrite-lath martensite-retained austenite whereas the pending claims recite a steel having martensite-retained austenite, such would not be a patentable difference since the additional phase of ferrite is not excluded by pending claim limitation "consisting essentially of" since the presence of ferrite would not appear to affect the basic and novel characteristics of the present invention in absence of proof to the contrary. Note that the steel of patent '714 with the presence of ferrite has a tensile strength (TS) of at least about 150Ksi, and therefore meets the pending claim TS property. Hence the presence of ferrite in US Patent 968 alloy would not affect the properties of the pending claims.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1 to 15 and 17 to 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US Patent 6,273,968) for the reasons set forth in paragraph 3.

7. Claims 1 to 15 and 17 to 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US Patent 4,619,714) for the reasons set forth in paragraph 4.

### *Response to Arguments*

8. Applicant's arguments filed 1-26-06 have been fully considered but they are not persuasive. It was submitted that the newly amended claim 1 reciting "consisting essentially of" clearly distinguishes the claimed process form the process and materials of the '714 patent. It is the examiner's position that "consisting essentially of" renders the claim open to the inclusion of unspecified elements which do not affect the characteristics of the composition. Note that the presence of ferrite does not affect the tensile strength of present invention since prior art steel can also be at least 150Ksi. Hence the additional ferrite in '714 patent is not excluded from applicant's claim 1.

9. It was argued that patent '968 discloses only conventional mean of performing cold working and does not disclose any means wherein the cold working is carried out

without heat treatment between stages. Moreover, lines 1 to 8 of column 6 of patent '678 cannot be read to contain any suggestion using any techniques other than conventional techniques for the further process of the disclosed alloys. It is the examiner's position that lines 1 to 8 in column 6 of patent '968 states the "...steel alloys of this invention are particularly useful in products that require high tensile strength and are manufactured by processes involving cold forming operations since the microstructure of the alloys lends itself particularly well to cold forming." Note that disclosure teaches cold forming operation with no mention of heat treatment; hence claims would not patentably distinguish over claims. Moreover, applicant's claim 1 recites a process "comprising". Since "comprising" opens claim to unrecited steps, then a heat treatment step would not be excluded.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Deborah Yee
Primary Examiner
Art Unit 1742

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